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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,746	02/21/2006	Hiroshi Taki	427972000700	9542

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EXAMINER	
CHEN, VIVIAN	
ART UNIT	**PAPER NUMBER**
1794	
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12/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/568,746	TAKI ET AL.	
	Examiner	Art Unit	
	Vivian Chen	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Withdrawal of Allowability

1. The indication of allowability of claims 5-10 have been withdrawn in view of Applicant's Amendments filed 10/9/2007 and the resultant new grounds of rejection.

Claim Rejections - 35 USC § 103

2. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

OKAJIMA ET AL (US 5,932,320).

OKAJIMA ET AL '320 discloses a clear polyester film, wherein the film is coated on at least one surface with a coating formed from an aqueous coating composition contains a copolyester containing a sulfonated comonomer (e.g., 5-sodium-sulfo-isophthalic acid) in typical amounts of 8 mol% and further contains a coupling agent (e.g., titanium chelate compound, etc.), wherein the typical ratios of copolyester to coupling agent are 20:10 to 65:10. The coating is typically applied to the polyester film and dried between stretching stages. (entire document, line 22-25, col. 5; line 26-35, col. 7; line 23-52, col. 8; line 55-64, col. 13; line 55-60, col. 14; line 58, col. 15 to line 65, col. 16; Tables 3-4; etc.)

It would have been obvious for one of ordinary skill in the art at the time the invention was made to use known titanium-based coupling agents in the coating layers of OKAJIMA ET AL in order to obtain films with improved adhesion to substrates and other layers. One of ordinary skill in the art would have selected the components in the coating composition in order to obtain the desired high degree of transparency (claim 2) required for specific applications. Regarding claim 1, the method of forming the coating layer is a product-by-process limitation

and is not further limiting in as so far as the structure of the product is concerned. "[E]even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). See MPEP 2113. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the product is unpatentable even though the prior product was made by a different process. The patentability of a product is based on the product itself, and is not dependent on its method of production.

3. Claims 5, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

OKAJIMA ET AL (US 5,932,320),

as applied in claim 1,

and further in view of MIZUNO (US 5,472,589) or MIZUNO (US 5,413,840).

MIZUNO '589 or '840 disclose that it is well known in the art to apply UV-curable acrylic-based hard coats to polyester films in order to provide improved protection and durability. (MIZUNO '589, line 18-23, col. 2; line 43-68, col. 4) (see corresponding portions of MIZUNO '840)

It would have been obvious for one of ordinary skill in the art at the time the invention was made to use known hard coat compositions the coated films of OKAJIMA ET AL in order to obtain protective films with improved durability. One of ordinary skill in the art would have selected the components in the coating composition in order to obtain the desired high degree of transparency (claim 7) required for specific applications. Regarding claim 5, the method of forming the coating layer is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). See MPEP 2113. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the product is unpatentable even though the prior product was made by a different process. The patentability of a product is based on the product itself, and is not dependent on its method of production.

4. Claims 3-4, 6, 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) OKAJIMA ET AL (US 5,932,320), as applied in claim 1; or

(b) OKAJIMA ET AL (US 5,932,320), in view of MIZUNO (US 5,472,589) or MIZUNO (US 5,413,840), as applied in claim 5;

and further in view of GEORGE ET AL (US 5,369,211).

GEORGE ET AL discloses that it is well known in the art to use sulfonated polyesters having a Tg greater than 89 C and a typical sulfonated comonomer (e.g., 5-sodiosulfoisophthalic acid) in amounts of 5-40 mol% to produce adhesives and/or coating binders with improved abrasion, heat and/or blocking resistance. (entire document, e.g., line 10-25, col. 1; line 16-30, col. 2; line 22-43, col. 3; etc.)

It would have been obvious for one of ordinary skill in the art at the time the invention was made to use known high Tg sulfonated copolyesters as binders in the coating composition of OKAJIMA ET AL in order to obtain films with improved heat resistance and non-blocking characteristics. One of ordinary skill in the art would have selected the components in the coating composition in order to obtain the desired high degree of transparency (claim 11-12) required for specific applications. Regarding claim 4, 6, the method of forming the coating layer is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious***

difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). See MPEP 2113. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the product is unpatentable even though the prior product was made by a different process. The patentability of a product is based on the product itself, and is not dependent on its method of production.

Response to Arguments

1. Applicant's arguments filed 10/9/2007 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 21, 2007

Vivian Chen
Primary Examiner
Art Unit 1794